

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Berez et al.

Group No.: 3733  
Examiner: Philogene, P.

Application No.: 10/724,010

Filed: November 25, 2003

For: Patient Selectable Joint Arthroplasty Devices and Surgical Tools Facilitating Increased Accuracy, Speed and Simplicity in Performing Total and Partial Joint Arthroplasty

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

STATEMENT FOR INFORMATION DISCLOSURE UNDER 37 C.F.R. SECTION 1.97(e)

NOTE: *A statement must state either: "(1) that each item of information contained in the information disclosure statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement, or (2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in Section 1.56(c) more than three months prior to the filing of the information disclosure statement."* 37 C.F.R. Section 1.97(e).

NOTE: *"Section 1.97(e) makes it clear that a certification could contain either of two statements. One statement is that each item of information in an information disclosure statement was cited in a search report from a patent office outside the U.S. not more than three months prior to the filing date of the statement. Under this certification, it would not matter whether any individual with a duty actually knew about any of the information cited before receiving the search report. In the alternative, the certification could state that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual having a duty to disclose more than three months prior to the filing of the statement." Notice of January 9, 1992, 1135 O.G. 13-25, at 13. (emphasis added). Thus: "If an item of information is submitted within three months of being cited in a communication from a foreign patent office in a counterpart foreign application, the certification can be properly made regardless of any individual's previous knowledge of the information." Id., 1135 O.G. at 19.*

NOTE: *"The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Thus, for example, the certification of Section 1.97(e) does not preclude the use of the certification in an application by corporations whose practitioners have over the years reviewed thousands of patents and technical publications, even though they are unaware of the relevance of any one thereof to the application. Notice of January 9, 1992, 1135 O.G. 13-15, at 19.*

NOTE: *A copy of the foreign search report need not be submitted with the certification. Notice of April 20, 1992 (1135 O.G. 37-41, 40).*

NOTE: *"The phrase 'after making reasonable inquiry' makes it clear that the individual making the certification has a duty to make reasonable inquiry regarding the facts that are being certified. The certification can be made by a registered*

*practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a certification under 37 C.F.R. 1.97(c)(2) to the Office until a satisfactory response is received. The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Notice of April 20, 1992 (1138 O.G. 37-41, 39).*

NOTE: *"Although it is recognized that an individual actually becomes aware of the information in the communication from a foreign patent office sometime after it was mailed, the mailing date of such a communication, if it occurs prior to a first awareness of the same information, would determine the date for filing of an information disclosure statement without a fee" in a certification procedure under Section 1.97(e). Notice of January 9, 1992, 1135 O.G. 13-25, at 19 (emphasis added).*

NOTE: *The mere absence of an item of information for a foreign patent office communication is not intended to represent an opportunity to delay the submission of a item known more than three months prior to the filing of an information disclosure statement to an individual having the duty of disclosure under Section 1.56. 62 Fed. Reg. 53,131, 53,150 (Oct. 10, 1997).*

NOTE: *"The certification under Section 1.97(e) should be made by a person who has knowledge of the facts being certified. The certification can be made by a practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry." Notice of January 9, 1992, 1135 O.G. 13-25 at 19.*

NOTE: *"The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application)." Notice of April 20, 1992 (1138 O.G. 37-41, 39).*

NOTE: *"Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent or inventor." 37 C.F.R. Section 1.56(d) and*

*"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:*

*(1) each inventor named in the application;*

*(2) each attorney or agent who prepares or prosecutes the application; and*

*(3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. Section 1.56(c).*

**IDENTIFICATION OF INFORMATION DISCLOSURE STATEMENT  
FOR WHICH THIS STATEMENT IS BEING MADE**

1. This statement is being made for the Information Disclosure Statement

☒ accompanying this statement.

☐ filed \_\_\_\_\_.

Date

**STATEMENT**

2. I, the person(s) signing below state:

☐ that each item of information contained in the information disclosure statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. 37 C.F.R. Section 1.97(e)(1).

*NOTE: The three month period starts from the mailing date of the foreign patent office communication. Notice of January 9, 1992, 1135 O.G. 13-25 at 19. The mailing date is the "date on the communication by the foreign patent office." Notice of April 20, 1992 (1138 O.G. 37-41, 39).*

**OR**

☒ that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, was known to any individual designated in Section 1.56(c) more than three months prior to the filing of the information disclosure statement. 37 C.F.R. Section 1.97(e)(2).

*NOTE: "The time at which information 'was known to any individual designated in 37 C.F.R. 1.56(c)' is the time when the information was discovered in association with the application even if awareness of the materiality came later." Notice of April 20, 1992 (1138 O.G. 37-41, 40).*

### IDENTIFICATION OF PERSON(S) MAKING THIS STATEMENT

3. The person making this statement is

*(check each applicable item)*

- (a) ☐ the inventor(s) who signs below

\_\_\_\_\_  
SIGNATURE OF INVENTOR

\_\_\_\_\_  
*(type name of inventor who is signing)*

- (b) ☐ a person who is substantively involved in the preparation or prosecution of the application, and who is associated with the inventor, with the assignee, or with anyone to whom there is an obligation to assign the application (37 C.F.R. Section 1.56(c)) and who signs below.

\_\_\_\_\_  
SIGNATURE OF PERSON MAKING STATEMENT

\_\_\_\_\_  
*(type name of person who is signing)*

\_\_\_\_\_  
Address of person who is signing

- (c) ☒ the practitioner who signs below on the basis of the information:

*(check each applicable item)*

- ☐ supplied by the inventor(s).  
☐ supplied by an individual designated in Section 1.56(c).  
☐ in the practitioner's file.

\_\_\_\_\_  
Alexander J. Smolenski, Jr., #47,953/

SIGNATURE OF PRACTITIONER

Reg. No.: 47,953

\_\_\_\_\_  
Alexander J. Smolenski, Jr.

*(type or print name of practitioner)*

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